

## REMARKS/ARGUMENTS

### Summary

Claims 20-32 are pending. Claim 20 has been amended to correct a grammatical error and claims 31 and 32 added. No new matter has been added.

### Priority

Applicants note the acknowledgement of the priority claim. The Office Action indicates that a certified copy of GB 0328923.8 was not filed as required by 35 U.S.C. 119(b). Applicants note, however, that the pending application is a 35 U.S.C. §371 nationalization of PCT/EP2004/052367 filed 29 September 2004. As indicated in MPEP 1828, the international bureau should furnish a copy of the certified copy to the USPTO.

### Rejection of Claims

Claims 20-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Mikkola (U.S. Patent Publication No. 2004/0024902) in view of the Tetra standards. Applicants traverse the rejections.

Claim 20 recites a method of radio communication in which a mobile station maintains a communication group set that comprises an ordered list of multiple user groups. This list is used for scanning for radio frequency activity among some or all of the groups. At least three of the user groups communicate together by direct mode communication on an associated direct mode radio frequency channel for the group. The mobile station periodically conducts a surveillance procedure to determine if there is any radio frequency activity comprising a communication amongst each group. Each of the direct mode radio frequency channels associated with the groups of the ordered list is sampled periodically to determine if there is any radio frequency activity comprising a direct mode communication on the direct mode radio frequency channel.

Thus, claim 20 specifically recites that the mobile station periodically determines whether direct mode communications are occurring on various RF carriers. Mikkola does not anticipate or suggest such a method. Instead, Mikkola discloses a method in which the various functions occur in indirect communications.

Specifically, Mikkola discloses an apparatus in which user data is transferred between media gateway controllers (see, e.g., paragraph [0002], claim 1 preamble). As

described, prior to Mikkola, the gateway intelligence is in a media gateway controller (MGC) and the actual switching/media transfer is performed in a media gateway. The media gateway informs the MGC whenever a calling event to which instructions may apply occurs and the MGC commands the media gateway to act according to a particular instruction. The problem with this is that it requires continuous message exchange between the MGC and the media gateway.

Mikkola created, in the media gateway, a user termination associated with the user that is not related to any specific call and directs all media streams via the user termination. Since the user termination is not call specific, part of the intelligence in the media gateway controller is transferred to the user termination and applied to all of the user's media streams. The user termination allows an intermediary between mobile devices that controls various functions of the calls (media gateways) to act without having to request instructions from the MGC. Note, however, that the user termination of Mikkola is a logical entity, not the physical mobile device recited in claim 1. Despite this, the following argument will assume that the user termination and the mobile device are the same.

The manner in which the system of Mikkola communicates is entirely different from the method of claim 20. As is well known, communications using direct mode operation (DMO), as recited in claim 1, occur directly between mobile devices -- that is mobile devices operating in DMO do not use system infrastructure to pass communications therebetween. The mobile devices of Mikkola, on the other hand, operate in indirect mode (TMO) in which infrastructure elements, such as a central control element, are present. Some of these infrastructure elements are clearly shown in Mikkola in Figs. 1-3 and described in the corresponding text (e.g., paragraphs [0043]-[0046]). These portions of Mikkola, among others, also show that the mobile device and gateways that are entirely separate from each other.

Turning to the specific paragraphs discussed in the Office Action, paragraphs [0085], [0089], [0092], paragraph [0085] merely states that certain parameters about group participation are modifiable by the user. Paragraphs [0089] and [0092] are directed to filtering simultaneous media streams to the mobile device. In particular, paragraphs [0089] and [0092] describe that by selecting priorities of the various groups of which the

mobile device is a member, the user termination can take traffic from a higher-priority group and interrupt traffic of a lower-priority group if the user has been listening to the latter. However, none of these paragraphs discuss this occurring in the mobile device or, further, in the mobile device using direct mode communications.

The Office Action notes that in paragraph [0082] Mikkola indicates that to join a group, a group attachment message is sent to the user termination. The group attachment message contains a parameter describing the group type. Mikkola indicates that the group type may be normal (TMO) or ad hoc group (DMO).

However, TMO messages have particular characteristics and thus a statement that this parameter is present in the message unsurprising. Mikkola in this sentence is merely describing what values the parameter generally takes. There is no disclosure in Mikkola that a mobile station can operate in DMO and make use of the mechanism described throughout the disclosure. Note that at no other place does Mikkola discuss an ad hoc group, and the above description is limited to a single sentence. This is because it is well known that attachment is terminology that is only used to describe the procedure of “linking” to a group in TMO attachment – no such procedure exists for DMO (as is evidenced by the DMO standard). Moreover, creating such a feature for DMO (as described in the instant specification) is a complicated technical undertaking that is far from trivial and is not described or enabled by Mikkola.

Further, even if this not the case, as Applicants have specifically indicated in the background of the instant application, it is not the case that all the functions that a central trunked system (such as that described by Mikkola) is capable of providing in a trunked mode of operation (TMO) can easily be replicated in the supplementary direct mode of operation (DMO), even if these functions are highly desirable. The function described in claim 1 is one of these functions.

As the CAFC has repeatedly held, an anticipating reference must be enabling; that is, the description must be such that a person of ordinary skill in the field of the invention can practice the subject matter based on the reference, without undue experimentation. *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1336 (Fed. Cir. 2008) (citing *In re Omeprazole Patent Litig.*, 483 F.3d 1364, 1379 (Fed. Cir. 2007)). In other words, the prior art must enable the claimed invention. *Minn. Mining & Mfg. Co. v. Chemque, Inc.*

(3M), 303 F.3d 1294, 1301 (Fed. Cir. 2002). As above, Mikkola describes TMO using the infrastructure (see, e.g., paragraphs [0001], [0020] among numerous other examples). TMO and DMO are entirely different communication modes, e.g., involving different features and protocols, and engendering different problems. A person of ordinary skill in the art cannot simply use the method of Mikkola on mobile station communicating using DMO. Mikkola does not enable his technique for DMO communications.

Mikkola is directed towards the need to filter between media streams (see, e.g., paragraph [0005]) using the infrastructure. As is apparent from the Tetra standard, conventional methods of scanning in TMO communications do not exist in DMO. Nor do DMO techniques extend from TMO techniques or vice-versa. Claim 1, on the other hand, recites monitoring and surveillance procedures in DMO, which permits participating in a DMO call (in one embodiment) and at the same time monitoring other RF carriers.

The Office Action combines the Tetra standard with the TMO method of Mikkola. As discussed above, these communication methods are extremely different and do not allow specific features to be used by extending procedures between the communication methods. In particular, the dedicated monitoring, surveillance rejection, and other call maintenance procedures of the Tetra standard do not merely extend from TMO procedures and cannot be used in conjunction with Mikkola.

In summary, claim 1 recites a mobile station while Mikkola is directed to a user termination. Claim 1 also recites DMO communications while Mikkola is directed entirely to TMO communications. Mikkola only indicates an attachment message has a parameter with particular values but does not describe anything further about one of these values. Thus, even if this sentence could be somehow read to Mikkola stating that attachment can be used in DMO communications, nowhere does Mikkola actually describe how attachment would operate in DMO. Thus, at the very best Mikkola is not an enabling disclosure for attachment using DMO communications.

Should the Examiner disagree with the above arguments, Applicants respectfully request that the next Office Action specifically rebut all points raised in this response.

Mikkola does not anticipate or suggest a method in which a mobile station periodically determines if there is any radio frequency activity on direct mode communication channels. Accordingly, claim 1 is patentable over the cited references.

Claims 21-30 are dependent on allowable claim 20. Thus, claims 21-30 are patentable without more.

**Conclusion**

Applicants respectfully requests that a timely Notice of Allowance be issued in this case and such action is earnestly solicited by the Applicants. Should the Examiner have any questions, comments, or suggestions, the Examiner is invited to contact the Applicants' attorney or agent at the telephone number indicated below. Applicants herein petition for any extension of time necessary for the filing of this response. Please charge any fees that may be due for this filing to Deposit Account 502117, Motorola, Inc.

Respectfully submitted,

SEND CORRESPONDENCE TO:

Motorola, Inc.  
1303 East Algonquin Road  
IL01/3<sup>rd</sup> Floor  
Schaumburg, IL 60196  
Customer Number: 22917

By: /Anthony P. Curtis/

Anthony Curtis  
Attorney of Record  
Reg. No.: 46,193

Telephone: 847-576-1974  
Fax No.: 847-576-0721  
Email: [acurtis@motorola.com](mailto:acurtis@motorola.com)